

**REMARKS**

The Office Action mailed \* has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

**Rejection(s) Under 35 U.S.C. § 103 (a)**

Claims 1, 24 and 36 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hawkins et al. (U.S. pat. no. 6,516,202, hereinafter, "Hawkins") in view of Zidel (U.S. pat. no. 6,330,436).

Hawkins is directed to an expansion unit for an organizer. The expansion unit is in the form of a cellular element 350 which plugs into the organizer 300 and provides the organizer with cellular communication capabilities.

Zidel is directed to an enhanced wireless messaging notification system. In Zidel, a message processing unit 70 docks into a wireless device 71 useful for "supplementing its operation."<sup>1</sup> The wireless device 71 is capable of receiving messages intended for the message processing unit 70 and is particularly useful in cases where the message processing unit is out of range, turned off, or has at low power level. The messages received by the wireless device 71 are delivered to the processing unit 71 when the two devices are docked together.

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<sup>1</sup> Zidel, col. 5, l. 3.

In Hawkins, when a call is received by cellular element 350, “the cellular element interrupts or wakes up the organizer, and otherwise interacts with the organizer to permit a user to take the telephone call.”<sup>2</sup> Unlike in the claimed invention, in Hawkins there is no “logic . . . capable of operation while the personal data assistant is mated to the housing and is running a separate application.”<sup>3</sup> Zidel is silent on this issue. Therefore, even if Hawkins and Zidel were properly combinable, the claimed invention would not .

The invention as claimed also specifies portability. Claim 1, for example, recites “a housing adapted to detachably mate with the personal data assistant and be portable therewith.” This portability is absent from Zidel, whose wireless device 71 is designed to provide a stationary power source for charging the power supply of the message processing unit 70.

In addition, in the claimed invention, for example according to Claim 1, the modem is “adapted to provide exclusive wireless communication capability for the personal data assistant.” This is not the case in Zidel, in which the wireless device 71 and the message processing unit 70 each has its own receiver for receiving messages.

The Office Action proposes the combination of Hawkins and Zidel in order to allegedly meet some of the limitations of the claimed invention—namely, “logic in communication with the communication device, wherein the logic periodically checks if communications have been received . . . independently of the connectivity between the communication device and the

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<sup>2</sup> Hawkins, col. 5, ll. 40 – 44.

<sup>3</sup> Claim 1.

personal data assistant,”<sup>4</sup> According to the Office Action, which acknowledges Hawkins’ failure to disclose that the logic may check for messages independently of the established communications link, “Zidel discloses the utility of providing a means for checking message notifications in an auxiliary device connected to a data processing device independent of the connection between them.”<sup>5</sup> The Office Action then reasons that “Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to Hawkins, as it would improve the chances of the device getting the message, as suggested by Zidel.”<sup>6</sup> Such reasoning, it is respectfully submitted, is grounded in impermissible hindsight. Zidel is a system for supplementing the message reception in a portable device by further providing a stationary device with a more reliable power supply and relatively unchanging location. Zidel therefore relies on redundancy, including providing two receivers—one on each device—which increases cost dramatically. If the teachings of Zidel were combined with those of Hawkins, there would be unnecessary duplication of parts. While Zidel is directed to *supplementing* one device with the other, Hawkins is directed to an *expanding* the capabilities of a device—namely an organizer. The expansion unit is in the form of a cellular element 350 which plugs into the organizer 300 and provides the organizer with *exclusive* cellular communication capabilities. The teachings of the two references are therefore incompatible.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

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<sup>4</sup> *Id.*

<sup>5</sup> Office Action, page 2, lines 19 – 21.

<sup>6</sup> *Id.*, page 2, line 21 – page 3, line 1.

or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>7</sup>

For the above reasons, these *prima facie* obviousness criteria are not met by the combination of the Hawkins and Zidel. Accordingly, it is submitted that the combination is improper and withdrawal of the rejection under 35 U.S.C. § 103(a) based on same is respectfully urged.

### **Conclusion**

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance. Such allowance is respectfully solicited.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

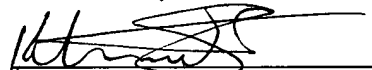
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<sup>7</sup> M.P.E.P § 2143.

Please charge any additional required fee, including those necessary to obtain extensions of time to render timely the filing of the instant Reply, or credit any overpayment not otherwise paid or credited, to our deposit account No. 50-1698.

Respectfully submitted,  
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